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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,915	10/19/2000	Hermann Bieringer	514413-3843	7663
20999	7590	09/01/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CLARDY, S	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 09/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

317.

## Office Action Summary

Application No.

09/691,915

Applicant(s)

BIERINGER ET AL.

Examiner

S. Mark Clardy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-33 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 27, 29-31 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

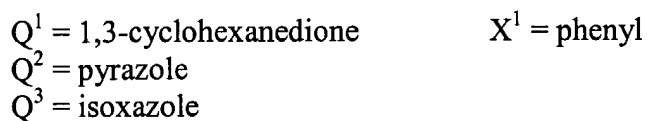
- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 26-33 are pending in this application. Applicants are requested to insert as the first line of the specification a claim to foreign priority (DE 19950943.3, filed October 22, 1999).

Applicants' claims 27-33 are drawn to herbicidal compositions and methods comprising:

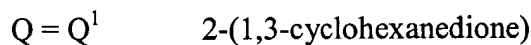
- A. A herbicide with various (hetero)cyclic groups connected by a carbonyl group:



- B. A second herbicidal component (see lists in claim 26).

Applicant's elected species is presented in claim 26 and comprises the following combination of active agents:

- A. The triketone herbicide, Compound "A4" (p. 26)<sup>1</sup>, wherein:



- B. The "B-b" group sulfonylurea herbicide, nicosulfuron (not used in the examples).

Claims 28 and 32 are held withdrawn from consideration as being drawn to a non-elected species (glufosinate/glyphosate, and  $Q^2$ , respectively). The election of species has been expanded to include component A herbicides comprising  $Q^3$ .

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<sup>1</sup>This compound differs from the triketone herbicide sulcotrione in having  $-\text{CH}_2\text{-O-CH}_2\text{-CF}_3$  at the 3-position of the benzoyl ring.

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It appears that the earlier misnumbering is still causing problems. The claims that were previously objected to were identified as those drawn to the elected species, i.e., renumbered claims 18 and 19 (filed in an amendment as claims 17 and 18): the first claim was drawn to the combination of A ( $Q^1$ -CO- $X^1$ ) and a second herbicide (from a list of 31 herbicides); the second claim was drawn specifically to the elected species A4 ( $Q^1$ -CO- $X^1$ ) + nicosulfuron. The data that had been presented October 15, 2002, was determined to be commensurate in scope with these two claims, and sufficient to overcome the obviousness rejection for these two claims. Claim 20 (or 19, as originally numbered), corresponding to new claim 27, was drawn to the generic composition as outlined above, and remains rejected below.

Claim 26, equivalent to canceled claim 19 (A4 + nicosulfuron) is allowable.

Claims 27, 29-31, and 33 are now rejected under 35 U.S.C. 103(a) as being unpatentable over any **one** of the following: Graber et al (PCT WO 97/34486), Luff (US 6,239,070), or Anderson-Taylor et al (PCT WO 97/22253).

Graber et al teach the combination of  $Q^3$ -CO- $X^1$  (benzoylisoxazole) herbicides with secondary herbicides (p. 6-9: dichloroacetamides, triazines, dinitroanilines).

Luff teach the combination of  $Q^3$ -CO- $X^1$  (benzoylisoxazole) herbicides with sulfonylurea herbicides.

Anderson-Taylor et al teach the combination of  $Q^3$ -CO- $X^1$  (benzoylisoxazole) herbicides with bromoxynil or ioxynil.

Note that these references have not been applied in combination.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' nonelected A ( $Q^3$ -CO- $X^1$ ) herbicides with

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secondary herbicides because the prior art teaches that several of applicants' Q3-CO-X<sup>1</sup> herbicides may be combined with secondary herbicidal agents; further, it is *prima facie* obvious to combine herbicidal agents<sup>2</sup>.

Again, the test data for the elected species presented in the response filed October 15, 2002, demonstrates synergistic activity for the elected composition. The test data presented with the response filed May 19, 2003, presents a comparison with the species comprising the triketone of De Gennaro et al (US 6,046,134, previously cited), and demonstrates unexpectedly superior synergistic results in comparison with the synergistic composition of De Gennaro et al.

Thus, applicants have presented data which demonstrate unexpected results for the elected species, and for the class of triketone herbicides comprising Q<sup>1</sup> and X<sup>1</sup>, i.e., the benzoyl cyclohexanediones.

Again, it is noted that the data presented to date is incommensurate with the scope of the claims. Objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. In re Tiffin, 171 USPQ 294.

Applicant may want to replace claim 27 with the claim originally presented as claim 17 and renumbered claim 18, discussed above.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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<sup>2</sup>It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069.

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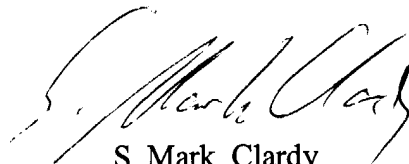
application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Mark Clardy  
Primary Examiner  
Art Unit 1616

August 30, 2004